

REMARKS

Claims 1-11 and 22 are pending in the application. Claims 1-4, 7-11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Design Patent No. Des. 425, 375 to Parham. Claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Design Patent No. D439,671 to Casillo et al. Claims 1, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,023,681 to Plant. For the reasons set forth below, reconsideration of the application is respectfully requested.

Initially, it should be remembered that the pending application has been limited to claims directed to a method of displaying a used wine cork using a holder that comprises holder comprises a base and at least two sidewalls. In some claims the holder is limited to one with the sidewalls having a length of between 0.25 inches and 4.0 inches, and the sidewalls being spaced between 0.5 inches and 1.5 inches apart.

In contrast, the prior art identified by the search report can be described generally as: (1) a suction cup mounted bottle holder (Parham) that appears to be sized to accommodate a baby bottle and which is therefore significantly larger than the claimed wine cork holder; (2) a baby bottle holder (Casillo) that is sized to accommodate a baby bottle and which is therefore significantly larger than the claimed wine cork holder; and (3) a knock-down wine bottle rack (Plant) that is sized to hold up to 116 standard wine bottles and which is therefore significantly larger than the claimed wine cork holder.

While it is appreciated that at least some of the identified references disclose structural elements (i.e., a base and/or sidewalls) that have features in common with the structural elements used in the method of the claimed invention, it should also be

appreciated that there are significant differences between the structural elements used in the method of the present invention and the structural elements disclosed by the prior art. In particular, the structural elements used in the method of the claimed invention are significantly different in size and function when compared to the structural elements disclosed by the prior art. While the method of the claimed invention uses a holder that is sized to hold a small wine cork, the floors and sidewalls of the prior art are sized to hold baby bottles or wine bottles, and would not function effectively to hold a small wine cork.

As to any suggestion that it would be obvious to modify the prior art by reducing the size to the size appropriate to hold a small wine cork, it is respectfully submitted that there is no teaching or suggestion in the prior art suggesting the proposed modification. Even if it were considered to be obvious to modify the prior art to accommodate somewhat smaller milk or wine bottles, there is nothing in the art teaching or suggesting that the size should be reduced enough to accommodate wine corks. That modification would not be merely a modest adjustment in size, it would be a complete reworking of the prior art structures to adapt them to a completely different purpose. Nothing in the cited art suggests such a modification.

Turning now to the specific rejections stated in the pending Action, the Office states that claims 1-4, 7-11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Design Patent No. Des. 425, 375 to Parham because “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have at least one pair of sidewalls with a length of between 0.25 inches and 4.0 inches, and wherein a pair of sidewalls is spaced between 0.5 inches and 1.5 inches apart,

wherein doing so would provide thereof a superior support of a wine bottle attached to the surface of a display holder.” The Office further states that it would be obvious to use the Parham device “as a method of displaying a used wine cork wherein doing so would provide thereof an additional support as to be perchance with enhancement of the appearance of the display holder.”

Initially, it is respectfully submitted that a holder with sidewalls between 0.25 and 4.0 inches in length that are spaced between 0.5 and 1.5 inches apart would not provide superior (or even adequate) support of a wine bottle. Persons skilled in the art know that wine bottles typically have diameters of between 3 and 4 inches, and such bottles cannot be supported by a pair of sidewalls spaced 0.5 inches to 1.5 inches apart.

Moreover, to the extent applicant understands the Office’s reasoning regarding why it would be obvious to place a cork from an opened wine bottle into a wine cork display holder in view of Parham’s teaching of a method of supporting a baby bottle, it is respectfully submitted that nothing in the cited prior art teaches or suggests anything about displaying used wine corks. The Office’s statement that “doing so would provide thereof an additional support as to be perchance with enhancement of the appearance of the display holder” does not seem to meet the Office’s duty to provide an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification, as required by MPEP §706.02(j).

Since there would be not superior support provided by the proposed modification (in fact, there would not even be acceptable support), there is no motivation to modify the cited prior art as proposed by the Office. Since the cited prior art suggests nothing regarding used wine corks or the problems associated with displaying them, there is no

motivation to use the Parham device to display a used wine cork. For both of those reasons, the rejection under 35 U.S.C. 103(a) should be withdrawn.

The Office also states that claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Design Patent No. D439,671 to Casillo et al. because “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use it as a method of displaying a used wine cork wherein doing so would provide thereof an additional support as to be perchance with enhancement of the appearance of the display holder.” To the extent applicant understands the basis of the rejection, it is respectfully submitted that the Office is simply incorrect in its contention that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use it as a method of displaying a used wine cork.” The Casillo device is not sized appropriately to display a used wine cork, and there is simply no suggestion or motivation to modify Casillo to accommodate a wine cork. Persons skilled in the art know that the device disclosed by Casillo is sized to accommodate baby bottles that typically have diameters of between 2 and 3 inches. Such a holder would not be appropriate for displaying used wine corks that are properly supported by a pair of sidewalls spaced 0.5 inches to 1.5 inches apart.

Moreover, there is no teaching or suggestion in the cited prior art that the Casillo device should be modified to accommodate used wine corks. Since there is no teaching or suggestion in the cited prior art to modify Casillo as proposed by the Office, the rejection under 35 U.S.C. 103(a) should be withdrawn.

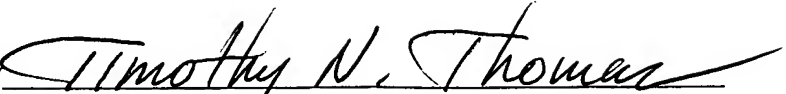
The Office also states that claims 1, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,023,681 to Plant because “it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use it as a method of displaying a used wine cork wherein doing so would provide thereof an additional support as to be perchance with enhancement of the appearance of the display holder.” To the extent applicant understands the basis of the rejection, it is respectfully submitted that the Office is again incorrect in its contention that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use it as a method of displaying a used wine cork.” The Plant device is not sized appropriately to display a used wine cork, and there is simply no suggestion or motivation to modify Plant to accommodate a wine cork. Persons skilled in the art know that the device disclosed by Plant is sized to accommodate wine bottles that typically have diameters of between 3 and 4 inches. Such a holder would not be appropriate for displaying used wine corks that are properly supported by a pair of sidewalls spaced 0.5 inches to 1.5 inches apart.

Moreover, there is no teaching or suggestion in the cited prior art that the Plant device should be modified to accommodate used wine corks. Since there is no teaching or suggestion in the cited prior art to modify Plant as proposed by the Office, the rejection under 35 U.S.C. 103(a) should be withdrawn.

In view of the fact that the claimed invention is limited to structures that are significantly different in size and function than the structures of the prior art, and in view of the fact that there is no motivation to modify the cited prior art as proposed by the Office, it is respectfully submitted that the claimed invention was not obvious at the time the invention was made. Reconsideration of the pending application is therefore respectfully requested.

Respectfully submitted,

By 

Timothy N. Thomas, Esq.,

Reg. No. 35,714

Woodard, Emhardt, Moriarty, McNett & Henry LLP

111 Monument Circle, Suite 3700

Indianapolis, IN 46204-5137

(317) 634-3456 Telephone

(317) 637-7561 Facsimile

Attorney for Applicant

#433473/bkp